

REMARKS

Applicants are in receipt of a non-final Office Action with regard to the matter captioned above. The Office Action is dated August 18, 2005, and it is asserted that, in view of the accompanying Petition for Extension of Time to respond and payment of the appropriate fee, this AMENDMENT is timely filed. The deadline, with extensions, is February 18, 2006. That date falling on a Saturday, the deadline for responding, with extensions, is February 21, 2006 in view of the fact that February 20 is a federal holiday.

Claims 23-26 and 28 were pending at the time the examiner reviewed the application and took action thereon. First, the examiner required new "corrected" drawings in compliance with 37 CFR § 1.121(d). Such "corrected" drawings were required in reply to the Office Action to avoid abandonment of the application, and the requirement for corrected drawings, the examiner indicated, would not be held in abeyance. Form PTO-948, a NOTICE OF DRAFTSPERSON'S PATENT DRAWING REVIEW, was attached to the Office Action papers. All of the bases for objection to the drawings derived from the fact that the drawing figures of record are informal. In response, Applicants hereby submit formal drawings and a LETTER TO OFFICIAL DRAFTSPERSON. Applicants submit that all objections to the drawings have now been obviated.

The examiner also objected to the specification as failing to

provide proper antecedent basis for the claimed subject matter. It was required that the written description and the claims use the same word. The only specific instance of non-parallel terminology pointed out by the examiner was use, in the claims prior to the entry of this AMENDMENT, of the term "effigy". By this document, "effigy" has been changed to read "character". It is submitted that this change is unnecessary, but the amendment of the terminology is made to move the case along.

Claims 23-26 and 28 are rejected under 35 U.S.C. § 112, first paragraph. The examiner was of the opinion that the written description requirement of that statutory section was not complied with. The examiner felt that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Further in view of this rejection, the examiner apparently believes that the claims present subject matter which is new and is not supported by the disclosure as originally filed. In fact, this appears to be the crux of the examiner's objections. Again, the examiner relied upon usage of the term "effigy". By this document, the terminology has been amended, as discussed above, to read "character". This terminology is in consonance with terminology in the originally-filed written description, including the claims.

Further, the examiner feels there is no support for other subject matter in the claims. For example, Claim 28 recites, at lines 7-17 thereof, "portraying at a location on the surface, proximate a first edge thereof, a first feature of an effigy head, and portraying on the surface a second feature of an effigy head, said first feature unrelated to said second feature when said item is in said first configuration, said features giving no suggestion of a complete effigy head when said item is in said first configuration". It should be pointed out that much of this language has been deleted, although it is not felt that it necessarily would have to have been so deleted. In any case, the language in Claim 28 now reads "portraying at a location on the surface, proximate a first edge thereof, a first feature of a character, and portraying on the surface a second feature of a character, said features giving no suggestion of a complete character when said item is in said first configuration".

Applicants submit that this language does not introduce "new matter", nor did the language in the claims prior to this AMENDMENT. It must be borne in mind that the specification, and particularly the DETAILED DESCRIPTION OF THE INVENTION, include reference numerals. Consequently, the drawing figures are incorporated by reference into the written description. It is within this context that the question of whether the description of the invention and the manner and process of making and using it is

described in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same. It is argued that, clearly, one of skill in the art would be enabled to practice the invention, as presently claimed, in view of the original disclosure when reference is made to the drawing figures. Attention is directed to FIGS. 1, 8 and 9 in particular. FIG. 1 illustrates two eyes that could, it is argued, be considered two separate features. When the flexible item is in its first configuration, as seen in FIG. 1, no context is given to the two eyes and, therefore, a complete character is not suggested. Further, if one were to consider the two eyes as a single feature, there is no suggestion of a complete character in view of a second, unrelated feature (hair defined by a fringe of the blanket). FIG. 9 shows, however, how context is given to suggest a character when the flexible item is manipulated in a manner as defined in the specification to "relate" the two features. Clearly, one of skill in the art would, therefore, find sufficient description in the specification, as originally filed, to support the claims, as presently written.

The examiner has also pointed out additional language which he apparently finds unsupported in the original specification. That language is "when it is in the second configuration, it gives context to a complete effigy by simulating a body of the effigy

with the features positioned appropriately with respect to the simulated body formed by the item to suggest the effigy's head". It is submitted that, with reference to FIGS. 8 and 9 in particular, as previously discussed, there is adequate description, as originally filed in the application, to support the present claims. Further, the present claims do not introduce new matter.

The final basis for rejection is 35 U.S.C. § 112, second paragraph. Claim 28 has not been rejected on this basis. Claims 23-26, however, are rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention in that the recitation "said feature" renders the claim vague and indefinite. This is the examiner's position in that Claim 28 recites both a first feature and a second feature. Claim 23 has now been amended to define a structure wherein "at least one of said features is portrayed on said first surface". It is submitted that the amendatory language obviates this rejection.

There is some degree of confusion with respect to the position taken by the examiner in the Office Action indicating that the "application is in condition for allowance except for formal matters", and the examiner's apparently reneging on this position when the telephonic interview was held on August 25, 2005. The present case has been pending since October 5, 2000, a period of approximately five and one-half years. Many of the positions taken

in the presently-outstanding Office Action are being posed for the first time. It is understood that, in an appropriate case, further searching is necessary after § 112 issues are cleared up. This would not appear to be one of those cases. The Patent and Trademark Office has had ample opportunities to search the prior art. In fact, during the five and one-half years the case has been pending, numerous searches have been conducted. Hardship after hardship has been brought to bear upon Applicants. Early on during prosecution, an interview was conducted with the examiner originally assigned to this matter. While the examiner, during that interview, did not formally indicate that the taking of certain action would place the case into condition for allowance, the undersigned, one of the named inventors and a principal of an assignee who traveled to the Patent and Trademark Office for the interview expected, in view of the examiner's comments, that the case would be allowed upon the taking of the action discussed. After returning from the interview, an appropriate amendment was filed. That paper was filed less than two weeks after the interview. The undersigned, when following up with the examiner shortly after filing of the document, discovered that the examiner who conducted the interview had left the Patent and Trademark Office.

The arguments offered with respect to prior art in the AMENDMENT filed June 7, 2005 are hereby renewed. In view of the

action taken by this document and the arguments offered in support of patentability of the claims, as they currently read, it is sincerely believed that this case is in condition for allowance. Allowance of the application and issuance of formal allowance papers are, therefore, earnestly solicited.

Please charge any deficiencies or credit any over payment to Deposit Account 14-0620.

Respectfully submitted,

Mary M. Ponthan et al.

By their attorney

Date

February 21, 2006

Lawrence M. Nawrocki

Lawrence M. Nawrocki

Reg. No. 29,333

NAWROCKI, ROONEY & SIVERTSON, P.A.

Suite 401, Broadway Place East

3433 Broadway St. N.E.

Minneapolis, MN 55413

Customer No. 05909

(612) 331-1464